

DOCKET NO.: MSFT-0103/127334.6
Application No.: 09/482,843
Office Action Dated: April 19, 2006

PATENT

Amendments to the Drawings

The attached sheet(s) of drawings includes changes to Fig(s) 1, 2, 3, 4, 5A, 5B, 6, 7, 8, 9, 10, 11, 12. The sheet(s), which includes Fig(s) 1, 2, 3, 4, 5A, 5B, 6, 7, 8, 9, 10, 11, 12, replaces the original sheet(s) including Fig(s) 1, 2, 3, 4, 5A, 5B, 6, 7, 8, 9, 10, 11, 12.

Attachment: Replacement Sheet(s)

REMARKS

The foregoing Amendment and the following Remarks are submitted in response to the Office Action issued on April 19, 2006 in connection with the above-identified patent application, and are being filed within the three-month shortened statutory period set for a response by the Office Action.

Claims 121, 124, and 126-135 remain pending in the present application. All claims have been amended. In addition, the specification has been amended to correct a minor matter, and a set of replacement drawing sheets with more proper margins has been provided. Applicants respectfully submit that no new matter has been added to the application by the Amendment.

The Examiner has stated that the declaration filed with the application on May 2, 2000 is defective as being unexecuted and also because alterations have been made to the [Supplemental] Declaration, and has required a new declaration. Applicants respectfully traverse the requirement for a new declaration.

In particular, Applicants note that the present application was filed as a divisional or continuation of a parent application, and that the present application as filed was accompanied by an executed copy of the Declaration from the parent application as well as an unexecuted copy of a Supplemental Declaration pertaining to the present application. Notably, the Supplemental Declaration lists five inventors (Peinado, Abburi, Bell, Blinn, and Manferdelli), all of which are also listed inventors from the parent application as set forth in the Declaration therefor. Correspondingly, the Supplemental Declaration did not list five other inventors (Jones, Venkatesan, England, Jakubowski, and Yu) that were listed as inventors from the parent application as set forth in the Declaration therefor. Also notably,

the PTO in issuing a filing receipt did correctly set forth the five inventors of the Supplemental Declaration and no others.

Applicants respectfully submit that although the Supplemental Declaration was not executed and contained an alteration (a date year), such Supplemental Declaration nevertheless acted as and was in fact accepted as a statement under 37 CFR 1.63(d)(1) and (2) to delete all but the named inventors of such Supplemental Declaration from the inventorship of the present application. In particular, such Rule 1.63(d)(1) and (2) states that:

(d)(1) A newly executed oath or declaration is not required under § .51(b)(2) and § 1.53(f) in a continuation or divisional application, provided that:

(i) The prior nonprovisional application contained an oath or declaration as prescribed by paragraphs (a) through (c) of this section;

(ii) The continuation or divisional application was filed by all or by fewer than all of the inventors named in the prior application;

(iii) The specification and drawings filed in the continuation or divisional application contain no matter that would have been new matter in the prior application; and

(iv) A copy of the executed oath or declaration filed in the prior application, showing the signature or an indication thereon that it was signed, is submitted for the continuation or divisional application.

(2) The copy of the executed oath or declaration submitted under this paragraph for a continuation or divisional application must be accompanied by a statement requesting the deletion of the name or names of the person or persons who are not inventors in the continuation or divisional application.

In fact, the parent application did contain the Declaration (i), the present application was filed by all or by fewer than all of the inventors named in the prior application (ii), the specification and drawings filed in the present application contain no matter that would have been new matter in the prior application (iii), and the executed Declaration filed in the parent application was submitted (iv). Accordingly, all that was

required was a statement requesting the deletion of the name or names of the person or persons who are not inventors in the continuation or divisional application. Applicants respectfully submit that such Supplemental Declaration though unexecuted did indeed serve as such a statement.

Specifically, such Supplemental Declaration / statement (hereinafter, 'statement') though unexecuted was filed under an executed transmittal along with the other application papers of the present application, and therefore enjoys the benefit of the signature of such transmittal, which is all that is required of such a statement. In addition, such statement did unambiguously set forth the names of those inventors to be deleted from inventorship in connection with the present application, at least by omission as compared with the supplied Declaration from the parent application, and also by positively setting forth the inventors of the present application. Finally, such statement was accepted as such at least in the course of issuing the filing receipt for the present application with the correct inventorship.

Accordingly, for all of the aforementioned reasons, Applicants respectfully submit that an actual declaration was not required under Rule 1.63 for the present application based on the submission of the executed Declaration from the parent application and also based on the submission of a Rule 1.63(d)(2) statement that in effect requested the deletion of the names of the persons who are not inventors in the present continuation or divisional application. Thus, Applicants respectfully submit that no new declaration is required, and respectfully decline to do so.

The Examiner has objected to the drawings for the reason that the margins thereof are improper. Accordingly, Applicants have submitted herewith replacement sheets of drawings with more proper margins.

The Examiner has objected to the specification because the Cross-Reference to Related Application sets forth the wrong year for the filing of the provisional application from which priority has been claimed. Accordingly, Applicants have amended the specification to correct the year from 1998 to 1999.

The Examiner has rejected the claims under 35 USC § 112, first paragraph. Applicants respectfully traverse the § 112, first paragraph rejection.

According to the Examiner, the term 'data structure' is not defined in the specification in an enabling manner and is not employed in a manner that is supported by a supplied dictionary definition. Accordingly, Applicants have amended the claims to remove such language and instead refer to a 'data file'. Applicants respectfully submit that 'data file' is believed to be supported by the specification of the present application, at least at about page 20, and is also known by the relevant public such that the term is enabled within the claims of the present application.

Accordingly, Applicants respectfully submit that the claim satisfy section 112, first paragraph. Thus, Applicants respectfully request reconsideration and withdrawal of the § 112, first paragraph rejection.

The Examiner has also rejected the claims under 35 USC § 112, second paragraph. Applicants respectfully traverse the § 112, second paragraph rejection.

According to the Examiner, the claims in the preambles thereof recite a data structure (file), yet the elements recited in the claims fail to define relationships therebetween which serve to distinguish the data elements as constituents of the data structure (file).

Thus, Applicants have amended at least claim 121 to further recite relationships between the data elements which serve to distinguish the data elements as constituents of the data structure (file). For example, claim 121 as amended now recites an interrelationship between the encrypted digital content and the content or package ID in that the encrypted digital content is decrypt-able according to a decryption key (KD) obtained from a license, and the content or package ID is employed to locate such license. Similarly, the recited license acquisition information as amended includes a location of a license provider for providing the license after identifying the content or package ID to such license provider, and the corresponding license includes a content provider digital certificate issued and signed by the content provider private key to show permission from the content provider to provide the corresponding license, such that the content provider public key from the package is employed to validate the content provider digital certificate of the corresponding license.

Thus, Applicants respectfully submit that the required functional interrelationships are now present in the claims as amended, and such relationships serve to distinguish the data elements as constituents of the data structure (file).

Also according to the Examiner, the preamble of claims 124 and 126-135 is not consistent with the preamble of claim 121. Thus, Applicants have amended all the preambles to refer to a computer-readable medium, or more simply 'the medium'.

The Examiner also notes that the fourth and fifth data fields in the dependent claims should now be fifth and sixth data fields. Thus, Applicants have so amended the claims.

Accordingly, and for all of the aforementioned reasons, Applicants respectfully submit that the claims satisfy section 112, second paragraph. Thus, Applicants respectfully request reconsideration and withdrawal of the § 112 rejection, second paragraph.

The Examiner has also rejected the claims under 35 USC § 101 as being non-statutory. Applicants respectfully traverse the § 101 rejection.

According to the crux of the Examiner's argument, the claims in essence recite non-functional descriptive material inasmuch as no requisite functionality and functional interrelationship is present so as to impart a practical application to the recited data file on the recited medium.

Thus, Applicants have amended at least claim 121 to provide such requisite functionality and functional interrelationship. In particular, in claim 121 as amended, the encrypted digital content of the package is decrypt-able according to a decryption key (KD) obtained from the license, and such license has the content or package ID of the package so that such content or package ID from the package can be employed to locate the license. In addition, the license acquisition information of the package includes a location of a license provider for providing the license after identifying the aforementioned content or package ID of the package to such license provider, and the package has a content provider public key so that a content provider digital certificate in the license can be validated to show that the content provider gave permission for the license provider to issue the license.

In addition, Applicants respectfully submit that inasmuch as claim 121 recites statutory subject matter, so too do dependent claims 124 and 126-135 recite statutory subject matter, at least by their dependency. Accordingly, and for all of the aforementioned reasons, Applicants respectfully submit that the claims satisfy section 101. Thus, Applicants respectfully request reconsideration and withdrawal of the § 101 rejection.

Finally, the Examiner has rejected the claims under 35 USC § 103 as being obvious over Erickson (U.S. Patent No. 5,765,152). Applicants respectfully traverse the § 103 rejection insofar as it may be applied to the claims as amended.

Independent claim 121 as currently amended now recites a computer-readable medium having stored thereon a data file corresponding to a digital content package. In particular, the data file includes fields representing:

- encrypted digital content to be rendered in accordance with a corresponding digital license, where the encrypted digital content is decrypt-able according to a decryption key (KD) obtained from the license;
- a content or package ID identifying one of the digital content and the package, where the corresponding license also has the content or package ID such that the content or package ID from the package is employed to locate the corresponding license;
- license acquisition information including a location of a license provider for providing the license after identifying the content or package ID to such license provider; and
- a content provider public key, where the corresponding license includes a content provider digital certificate issued and signed by a corresponding content provider private key to show permission from the content provider to provide the

corresponding license, such that the content provider public key from the package is employed to validate the content provider digital certificate of the corresponding license.

Thus, upon a user selecting the file with the package, the user can attempt to render the content of the package by way of the license by employing the ID of the package to locate such license in a local store or the like. Alternatively, if the license is not located, the ID can be sent along with a license request to a license provider for the license by directing such license request with the ID to the location set forth in the license acquisition information of the package. Upon receiving the license, the content provider digital certificate therein is validated by way of the content provider public key of the package to ensure that the license provider did in fact have permission to issue the license.

The Erickson reference sets forth a system where content is packaged in a secure electronic format, and registered on associated registration server, which serves to provide on-line licensing and copyright management for that media. Packages with content are registered on the server and made available for use and possible license through an authorization server. (Abstract)

As best seen in Fig. 1A, a typical package includes an ID (document ID 22) and the content (in the data container 23). However, it does not appear that the content is encrypted, as is required by claim 121, especially inasmuch as the content can be viewed without a license (Abstract) that would have a decryption key for decrypting such encrypted content, as is required by claim 121. Alternatively, if the content is encrypted, the package of the content would have to have the decryption key and not any license, as is required by claim 121, especially inasmuch as the content can again be viewed without such a license.

Notably, the Erickson reference does not disclose or even suggest that any license issued for the content of the Erickson package should or could have a content provider digital certificate issued and signed by a corresponding content provider private key to show permission from such a content provider for the any Erickson entity to provide the corresponding license, as is required by claim 121, and would not have such a certificate inasmuch as the Erickson system presumes the license provider and content provider are one and the same. At any rate, without such a certificate, it follows that the Erickson content package also does not have a content provider public key that is employed to validate the content provider digital certificate of the corresponding license, as is also required by claim 121.

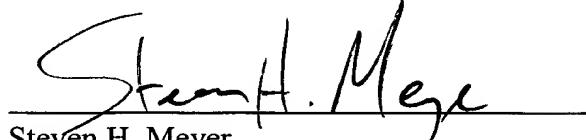
Thus, Applicants respectfully submit that the Erickson reference does not make obvious independent claim 121 or any claims depending therefrom. Instead, Applicants respectfully submit that such claims are not in fact obvious in view of the cited references, and accordingly, Applicants respectfully request reconsideration and withdrawal of the § 103 rejection.

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In view of the foregoing discussion, Applicants respectfully submit that the present application, including claims 121, 124, and 126-135 is in condition for allowance, and such action is respectfully requested.

Respectfully Submitted,

A handwritten signature in black ink, appearing to read "Steven H. Meyer", written over a horizontal line.

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